



JFW

Patent
Attorney Docket No. 4389

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant: Brian E. Dalton)
Application No.: 10/642,976)
Filed: August 18, 2003)
For: CERVICAL COMPRESSION PLATE)
ASSEMBLY)
)
) Swiger III, James L.
) Patent Examiner
) Art Unit 3733
Pittsburgh, Pennsylvania

REPLY TO EXAMINER'S ANSWER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner's Answer requires a response in regard to the Examiner's arguments set forth under Section (10) Response to Argument. Appellant therefore replies as follows:

(10) RESPONSE TO ARGUMENT

The Examiner states that "The functional limitation of being 'configured to' is similar to 'capable of' where it has been held at the recitation that an element is 'capable of' performing a function is not a possible limitation but only requires the ability to so perform and further does not constitute a limitation in any patentable sense." In this regard the Examiner cites *In re Hutchison*, 69 USPQ 138.

This analysis made by the Examiner is completely inaccurate. The limitation "configured to" specifically means that the device so configured must have the required dimensions and contours to carry out the required function. To the contrary, the term "capable of" implies no such physical limitations and therefore the Examiner's analysis does not follow. The term "configured to" cannot be considered equal to the term "capable of". It is respectfully submitted that while the term "capable of" is not a positive limitation, that nevertheless, the term "configured to" is in fact a positive limitation. Therefore, the ruling of In re Hutchison does not apply.

In conclusion, the references or any combination thereof do not suggest Applicant's invention as claimed, and the Examiner's rejection should be overturned.

Respectfully submitted,

CAROTHERS AND CAROTHERS



Floyd B. Carothers
Attorney for Brian E. Dalton
Fort Pitt Commons, Suite 200
445 Fort Pitt Boulevard
Pittsburgh, PA 15219

FBC:jkc
Reg. No. 24,252
(412) 471-3575
(412) 471-3597 Fax
Pittpatent@aol.com

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 12, 2008

CAROTHERS AND CAROTHERS

